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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ROBERT'S MLOTKOWSKI SAFRAN & COLE, P.C.

Intellectual Property Department

P.O. Box 10064

MCLEAN, VA 22102-8064

EXAMINER

LONEY, DONALD J

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

03/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lgallaugh@rmsclaw.com

dbeltran@rmsclaw.com

bdiaz@rmsclaw.com

Office Action Summary

Application No.

10/596,201

Applicant(s)

DIERKS, KARL-JOSEF

Examiner

Donald Loney

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date 06/02/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 27 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In both claims there is no antecedent basis for the recitations therein. It appears that both claims may have been intended to depend from the immediately preceding claim since they appear to have the antecedent basis therefor. Clarification and/or correction is kindly requested.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18, 19, 22, 23, 25 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/27429 cited by the applicant.

WO 01/27429 discloses a glazing unit comprising two glass panes 1, a fastener 3 for fixing the glass panes, a sealing element comprising an intermediate portion 2, two lateral gaps seals 44 and a cushion 14 situated between the gap seals per claims 18 and 19. Refer to figures 3, 4, 6, 8 and 9. Alternatively, the two seals 4, on each side of

the intermediate spacer, could be considered the gap seals and cushions per claims 18 and 19. With regards to claim 22 and 23, the cushion has what can be considered a metal coating 8 thereon. With regards to claim 25, this process limitation, in a product claim, does not distinguish from the prior art. With regards to claim 30 and 31, the spacer 2 is a hollow metal profile as disclosed.

5. Claims 18, 19, 25, 32 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0250386.

EP '386 discloses a glazing unit comprising two glass panes 1, 2 a fastener 20 for fixing the glass panes, a sealing element comprising an intermediate portion 16, two lateral gaps seals 27 and a cushion 18 situated between the gap seals per claims 18 and 19. Refer to figure 8. With regards to claim 25, this process limitation, in a product claim, does not distinguish from the prior art. With regards to claims 32, 35 and 36, the fastener 20 comprises a U-shaped profile as shown in the figure 8.

6. Claims 18, 19, 21, 22 and 25-32 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Newby et al (5512341).

Newby et al discloses a glazing unit comprising two glass panes 3, 4, a fastener 2 for fixing the glass panes, a sealing element comprising an intermediate portion 7, two lateral gaps seals 14 and a cushion 8 situated between the gap seals per claims 18 and 19. See figure 3. With regards to claim 21, see column 5, lines 33-40. With regards to claim 22, see coating 13. With regards to claim 25, this process limitation, in a product claim, does not distinguish from the prior art. With regards to claim 26 and 27, see column 11, lines 22-25. With regards to claims 28 and 29, the gap seals 14 are located

in a trough between two sections of the cushion. See the two ribs on the right and left side of the spacer in figure 3 and 5 where the gap seals 14 are located. With regards to claim 30 and 31, see column 8, lines 1-4. With regards to claims 32 and 35, the fastener is a U-shaped clamp 2 as shown in figure 3.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 20, 23, 24, 33 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newby et al.

The primary reference teaches the invention substantially as recited except for the various limitations per the above claims. See the 35 U.S.C. 102 rejection above.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Newby et al to form the cushion of a shore hardness as indicated in claim 20, motivated by the fact one would use whatever hardness is needed

for a particular application. With regards to claim 23 and 24, it would be obvious to substitute metal for the coating of Newby et al since this would also form an air tight seal. With regards to claim 33, it would be obvious to form the frame of metal, motivated by the fact Newby et al discloses the materials for the unit can be assembled with known materials in the art (see column 6, line 66 through column 7, line 2). With regards to claims 36 and 37, to include a bulge on the frame legs would be obvious to include for its biasing means against the glass sheets. With regards to claims 38 and 39, it would be obvious to form the frame of multiple sections since this would merely involve making the parts separable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Donald J. Loney/
Primary Examiner
Art Unit 1794

DJL;D.Loney
03/01/09